

REMARKS/ARGUMENTS

Status of Claims

Claims 1 to 4, 6 to 8, 11 to 14, 16 and 18 to 24 are pending in the application.

35 U.S.C. § 103 Claim Rejections

Applicant understands that the Examiner has rejected claims 1 to 3, 6 to 8, 11 to 14, 16 and 18 to 24 under 35 U.S.C. § 103(a) as obvious having regard to Noel et al. (Noel), U.S. Publication No. 2005/0032539 in view of Forssell et al. (Forssell) U.S. Patent No. 6,671,511. Applicant notes that paragraph 8 beginning at the top of page 6 of the Official Action makes reference to anticipation under 35 U.S.C. § 102(e). Based on a previous conversation with the Examiner, Applicant understands that the reference to 35 U.S.C. § 102(e) and anticipation in paragraph 8 is a typographical error and that paragraph 8 is directed to an obviousness objection under 35 U.S.C. § 103(a). The comments below are therefore limited to a response to the obviousness rejection.

Applicant respectfully traverses the obviousness rejection.

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d, 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. Additionally, in making a rejection under 35 U.S.C. § 103(a) on the basis of obviousness, the Examiner must provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Only if this initial burden is met does the

burden of coming forward with evidence or argument shift to the applicant. *See Oetiker*, 977 F.2d at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

Applicant's analysis below demonstrates that the Examiner has failed to fulfil the initial burden for a finding of obviousness under 35 U.S.C. 103.

Applicant submits that claims 1 to 3, 6 to 8, 11 to 14, 16 and 18 to 24 of the present application are patentable over Noel in view of Forssell as the Examiner has not properly determined the differences between the claimed invention and the prior art. Furthermore, the Examiner has not provided a valid explanation to support an obviousness rejection under 35 U.S.C. § 103. Applicant's reasoning is detailed below.

Differences between the claimed invention and the prior art

The following is a discussion of why the cited references do not disclose all the elements of the rejected claims. While it may be considered that "the mere existence of differences between prior art and an invention does not establish the invention's non-obviousness", Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one skilled in the art (Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR international Co. v. Teleflex Inc.*, published in Federal Register Vol. 72, No. 195, October 10, 2007). As such, if elements from a claim are not disclosed by the combination of cited references and no valid reasoning is provided why the missing elements would be obvious, this may provide a strong basis for why a claim should not be rejected based on obviousness.

The present invention provides a method, system and device for a listener's device in such a scenario to transmit a message, specifically a transmit channel request message (TCRM), to a talker's device. The TCRM is sent over a logical control channel from the listening device to the transmitting device while the transmitting device is in possession of the transmit channel in the half-duplex session. The TCRM indicates that the transmit channel is requested.

In rejecting the claims in view of Noel, the Examiner refers to paragraphs [0004], [0019] to [0023] and [0025] of Noel. Paragraphs [0004] and [0019] to [0022] deal with the “normal” operation of Noel as shown in the flow chart of Figure 3. Paragraphs [0023] and [0025] deal with the “interrupt function” of Noel as shown in Figure 4.

A. The “Normal” Operation of Noel

i) The Message

Noel teaches mobile devices 110 in a wireless network 130. The mobile devices 110 are connected to a push-to-talk (PTT) server 140 (see paragraphs [0019] and [0020] of Noel). In the “normal” operation of Noel, a call originator selects the participants for the call. The identities of the participants are stored in a PTT server. Each of the participants in the call is assigned a priority level. The priority level is stored in the PTT server. The call then begins with the call originator communicating with the other participants via the mobile device 110 (see paragraph [0021] of Noel). It is important to note that the identity and priority of each of the participants is stored in the PTT server 140. It is not stored in the mobile 110.

“As the call progresses, a participant may want to speak while another participant is currently speaking”. In order to do so, the participant who wishes to speak can press a push-to-talk button on the mobile device 110. “This request is received by the PTT server 140 (230)”. The request is not received by the mobile device of the participant who is currently speaking. “After the request is received, the PTT server 140 compares the assigned priority level of the call participant initiating the request with the priority level of the current speaker (240)”. If the call participant initiating the request has a lower priority level than that of the current speaker, the call participant initiating the response is placed in a queue in the PTT server 140. No message whatsoever is sent to the participant who is currently speaking (see paragraph [0022] of Noel). It is the PTT server 140 that ultimately processes the request to talk, not the participant who is speaking. This is in contrast to claim 1 of the present application in which the request is sent to the device which is transmitting.

The Examiner equates the TCRM message sent by the first user device to the network and then forwarded to the second user device, as recited in claim 1, with two separate messages

in Noel. In Noel, the participant who requests the ability to speak sends a request to the PTT server 140. The PTT server 140 does not forward this message to a participant who is currently speaking. If the priority of the participant who requests the ability to speak is greater than the participant who is currently speaking, then the PTT server 140 sends a message to the participant who requests the ability to speak that displays the queue position of the call participant initiating the request. The PTT server 140 also sends a message to the other participants “indicating a change in speaker is set to occur (270). Concurrent with the change of speaker message being sent, the current speaker loses their ability to transmit speech and is placed in the queue in an order appropriate for her assigned priority level (280)” (see paragraph [0022] of Noel). Therefore, in this scenario, no TCRM message sent by a first user device to a network is then forwarded to a second user device as recited in the claims. The message sent by the PTT server 140 to the other participants can not be considered a message indicating that the requestor wishes to speak on the transmit channel. It would make no sense to send such a message in the normal operation of Noel because the mobile devices have no control over who will speak. A message which indicates that a change of speaker is set to occur can in no way be construed to be a transmit channel request message indicating that the requestor requests to use the transmit channel.

If the requester has a lower priority level, then the requester is placed in a queue and a message indicating this is sent to the requester. No message is sent to any device other than the requesting device.

Claim 1 recites that the transmit channel request message indicates that the first user device has requested use of the transmit channel. The message of the present claims is a request for the use of a channel. In Noel, while a message requesting use of a channel may be sent by a first user device to a network, that message is not forwarded on to a second user device. In Noel, the request travels only as far as the PTT server 140. The determination of who can speak is made only in the PTT server 140. If the PTT server 140 determines that the person wanting to speak has a lower priority level, no message at all is sent to the mobile device of the person currently speaking or other participants. If the PTT server 140 determines that the person wishing to speak has a higher priority, again no request is sent to the device of the person currently speaking. Instead, what is sent to all participants is a notice that the speaker will

change and the participant who is the current speaker loses the ability to transmit speech. Thus, the “normal” operation of Noel never transmits to the second user device a transmit channel request message indicating that the first user device has requested use of the transmit channel as claimed in claim 1 of the present application.

ii) The Identity of the Participant Who Wants to Speak

Further, claim 1 teaches that the request includes the identity of the participant who wants to speak. The Examiner’s entire position in paragraphs 7 and 8 of the Official Action concerning Noel is based on this “normal” operation of Noel. Since the “normal” operation of Noel never sends a message to the current speaker requesting use of the channel to speak, Noel does not send a message to a second user device that includes identifying the participant who is requesting the channel and therefore, this element of claim 1 is also not taught by Noel.

B. The “Interrupt” Function of Noel

i) The Identity of the Participant who wants to Speak

Paragraphs [0023] and [0025] of Noel describe the flowchart of Figure 4 in Noel.

An interrupt function disclosed in Noel gives a listener the option of pressing an interrupt button to request to be able to speak if that call participant has an urgent matter to discuss. As explained in paragraph [0025] of Noel, “[o]nce the interrupt button is pressed, the PTT server 140 sends a message to the current speaker that one of the call participants wants to interrupt the call on a urgent basis (450). After the message is received by the mobile device 110 of the current speaker, the current speaker has the option of allowing the call participant initiating the request to speak or placing the call participant into the queue”.

No where is it disclosed in paragraph [0023] or [0025] that the result of the participant pressing the interrupt button is a TCRM message being sent to the network. Noel discloses that “A call participant typically uses an interrupt button to request the ability to speak”. The interrupt button is inferred to be a separate button than that of the PTT button described as being pushed in the “normal” embodiment of Noel above. Applicant submits that if the interrupt button was not a separate button with a different mode of operation than the button used for PTT

during “normal” operation, there would be nothing to differentiate between the “normal” operation and the “interrupt” functionality. Pressing a button to request the ability to speak as disclosed in Noel is so broad as to encompass potentially every manner of making a request, but without any general suggestion of how it may be done. For example, the interrupt button for each device may be assigned a different tone such that when the interrupt button is pressed for a given device and the tone transmitted, the base station identifies the device by the tone used. Such a method would not be message based. This is in contrast to claim 1 that clearly recites that it is a TCRM message sent by the first user device that is then forwarded to the second user device. The use of the TCRM message as recited in claim 1 is a specific manner of requesting the ability to speak.

Therefore, once again, Applicant submits that Noel does not disclose a first user device sending a TCRM message to the network and that same TCRM message being forwarded to a second user device.

ii) A Qualifier Flag and Extended Functionality

Claim 1 also recites that the TCRM includes a qualifier flag when the TCRM is forwarded to the second user device and extended functionality is performed by the second user device performed in response to a value of the qualifier flag.

The Examiner concedes that Noel fails to specifically mention “receiving a qualifier flag and performing extended functionality in response to a value of the qualifier flag”. The Examiner points to Forssell, and in particular column 9, lines 11-44, as disclosing this limitation. However, the passage of Forssell referred to by the Examiner describes only communication between a mobile station and a network. It nowhere refers to a second user device. Since Forssell does not disclose a second user device receiving a request message and therefore does not disclose sending a TCRM including a qualifier flag at least when the TCRM is forwarded to the second user device, this limitation is not met by Forssell.

Furthermore, since for at least the reasons described above that Noel does not describe the network forwarding the TCRM to a second user device, Applicant submits that neither alone or in combination do Noel and Forssell teach the limitation of “the network forwarding he

TCRM to a second user of said plurality of user devices” and “the TCRM including a qualifier flag at least when the TCRM is forwarded to the second user device.”

For at least the reasons discussed above, Applicant respectfully submits that the combination of Noel and Forssell does not teach all the limitations recited in claim 1. Furthermore, the Examiner has failed to explain why the missing limitations would be obvious to one skilled in the art. Without all the limitations of claim 1 being disclosed by the two references and no reason provided by the Examiner why these missing limitations would be obvious, Applicant submits that there are differences between what is recited in claim 1 and what is disclosed in the cited art that renders the claims non-obvious.

Reason to Combine

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. An obviousness inquiry requires a review of a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. For the Patent Office to combine references in support of an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references *KSR Int’l v. Teleflex, Inc., No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007)*, Id. at 15. Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template.

Applicant submits that there is no suggestion of a desirability of the claimed invention in the references that would serve as a reason for one skilled in the art to combine the references.

The Examiner’s motivation for combining Forssell and Noel is tied to a view that Noel and Forssell teach the particular limitations of claim 1. As detailed above, this is an incorrect interpretation of the references and as such this also affects the Examiner’s reason for combining the cited references.

The Examiner alleges that “[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art to transfer information (Forssell) allowing efficient and organized queuing of call participants (Noel)”. Even if what is disclosed in Forssell were to be considered equivalent to the specific limitation of claim 1 to which it is being equated, which Applicant does not concede, Applicant submits that without a suitable reason, the combination of references is improper. There is no reason to combine Forssell with Noel. Forssell is concerned with the problem of how to transfer delay sensitive data in a packet radio service. This is unrelated to the problem of Noel of how a call originator can control who speaks in a half-duplex call.

In the Response to Arguments section on page 5 of the present Office Action, the Examiner alleges that Forssell discloses receiving a qualifier flag and performing extended functionality in response to a value of the qualifier flag. Even if Forssell did disclose such limitations, which Applicant does not concede, such activities occur between a mobile station and a network to which the mobile station is connected to. The network is not the same as a second user device recited in present claim 1. Applicant submits that the network would be more analogous to the PPT server 140 of Noel in that it is an intermediary between a first user device and a second user device. The Examiner has failed to provide evidence why one skilled in the art would equate the network in Forssell with the mobile device of the participant who is currently speaking, and not the more logical choice of the PTT server in Noel in a proposed combination of Noel and Forssell. Without evidence as to why one skilled in the art would make the choice to modify the system of Noel with the subject matter identified by the Examiner in Forssell in a manner that is opposed to the logical choice of modifying the PTT server as the intermediary node in the network, which is equivalent to the network in Forssell, Applicant submits that the Examiner has failed to provide sufficient evidence for a suitable reason for combining the references.

Furthermore, in the Response to Arguments section on page 5 of the present Office Action, the Examiner responds to Applicant’s previous arguments that there is no suggestion to combine references by stating that “the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claims invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art”. The Examiner follows this statement by simply arguing that “it would have been it would have been obvious to a person of ordinary skill in the art to transfer information in a packet radio service allowing sufficient radio resources for the mobile station (Forssell) further allowing for an organized and efficient call (Noel)”. Yet the Examiner provides no reason why such a combination would be obvious, other than saying it would be. Applicant submits that such a position does not fully support a *prime facie* case of obviousness, especially in view of Applicant’s comments submitted above.

The Examiner also suggests that Noel and Forssell are “in a similar field of endeavour”. Other than Noel and Forssell disclosing wireless communications, the Examiner has not provided sufficient evidence that the two references are in “a similar field of endeavour”. Applicant submits, as mentioned above, that Forssell is concerned with the problem of how to transfer delay sensitive data in a packet radio service. This is unrelated to the problem of Noel of how a call originator can control who speaks in a half-duplex call.

For at least the above reasons, Applicant submits that the Examiner has failed to provide a suitable reason for combining the references.

In view of the foregoing, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness and that claim 1 of the present application is patentable over Noel and Forssell, Applicant respectfully requests the Examiner reconsider and withdraw the obviousness rejection of claim 1.

Claims 2, 3, 6 to 8 and 11 depend from claim 1, either directly or indirectly. Device claim 12, network claim 21 and memory claim 24 are independent claims that recite limitations that are substantially the same as claim 1. Claims 13, 14, 16, 18 to 20, 22 and 23 depend directly or indirectly from device claim 12.

For at least the reasons discussed above concerning the rejection of claim 1, Applicant submits that claims 2, 3, 6 to 8, 11 to 14, 16 and 18 to 24 patentably distinguish over Noel and Forssell.


The Examiner has rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over Noel in view of Stubbs, U.S. Patent No. 6,930,994.

The Examiner points to Stubbs as teaching wherein the half-duplex session is a voice communication session compliant with at least one system selected from the group of iDEN.TM., 1XRTT CDMA, GSM/GPRS, UMTS, and TDMA. Claim 4 depends from claim 1. Even if Stubbs teaches what is alleged by the Examiner, Stubbs does not overcome the deficiencies of the combination of Noel and Forssell outlined above concerning the rejection of claim 1. Accordingly, the combination of Noel and Stubbs does not render claim 4 obvious.

In view of the foregoing, early favorable consideration of this application is earnestly solicited. In the event that the Examiner has concerns regarding the present response, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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